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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,565	06/05/2000	Yoshinori Miyazawa	1046.1214/JDH	7602

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EXAMINER
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NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

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DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/587,565

Applicant(s)

MIYAZAWA, YOSHINORI

Examiner

Dustin Nguyen

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-8, 10-14, and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1, 2, 4 – 8, 10 – 14, 16 – 18, are presented for consideration.

#### ***Response to Arguments***

2. As per remarks, Applicant's argued that (1) Hara and Birrell, either alone or in combination, disclose a judging unit which "judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time".
3. As to point (1), Hara discloses extracting means for extracting the mail address of the transmission destination candidates [ i.e. sender and global addresses ] [ col 2, lines 64-67; and col 3, lines 51-60 ] and a response should be returned to multiple destinations [ col 3, lines 61-col 4, lines 11 ]. Furthermore, Birrell discloses a reply message to plurality of email addresses [ col 12, lines 16-21; and col 14, lines 36-41 ].
4. As per remarks, Applicants' argued that (2) Hara and Birrell, either alone or combination, disclose a mail address book by which whether or not the reply destination mail address extracted from the mail header of the E-mail received is the address of the mailing list, can be judged.

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5. As to point (2), the limitation is rejected as mentioned in previous Office Action.

Furthermore, Hara discloses the reply destination mail address extracted from the mail header of the E-mail received is the address of the mailing list [ i.e. global address ] [ col 4, lines 48-56 ].

Also, Birrell discloses the above limitation [ i.e. Reply to All ] [ col 12, lines 16-21; and col 14, lines 36-39 ].

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4 – 8, 10 – 14, 16 – 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara [ US Patent No 5938725 ], in view of Birrell et al. [ US Patent No 6189026 ].

8. As per claim 1, Hara discloses the invention substantially as claimed including an E-mail terminal device comprising:

a judging unit which judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time [ col 3, lines 51-60; and col 4, lines 48-56 ];

a selecting unit which displays the at least one extracted mail address as a candidate for a reply destination from which a specified reply destination can be selected [ col 3, lines 14-28; and col 4, lines 2-11 ].

Hara does not specifically disclose

an extracting unit which extracts, when the reply destination mail address is the address of the mailing list, at least one mail address contained in a text of the E-mail received.

Birrell discloses

an extracting unit which extracts, when the reply destination mail address is the address of the mailing list, at least one mail address contained in a text of the E-mail received [ col 10, lines 45-48 ].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Birrell because Birrell's teaching would automate the reply process which helps to reduce the processing time.

9. As per claim 2, Hara discloses the invention substantially as claimed including an E-mail terminal device comprising:

a first extracting unit which extracts a reply destination mail address from a mail header of an E-mail received [ Figure 4; col 2, lines 64-67; and col 6, lines 18-26 ];

a selecting unit which displays all the extracted mail addresses as candidates for reply destinations from which a specified reply destination can be selected [ col 3, lines 1-3; and col 6, lines 29-40 ];

a judging unit which judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time [ col 3, lines 51-60; and col 4, lines 48-56 ];

Hara does not specifically disclose

a second extracting unit which extracts at least one mail address contained in a text of the E-mail received;

wherein the second extracting unit, when the reply destination mail address is judged to be the address of the mailing list, extracts the at least one mail address.

Birrell discloses

a second extracting unit which extracts at least one mail address contained in a text of the E-mail received [ col 10, lines 45-48 ];

wherein the second extracting unit, when the reply destination mail address is judged to be the address of the mailing list, extracts the at least one mail address [ col 10, lines 63-col 11, lines 6 ].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Birrell because Birrell's teaching would automate the reply process which helps to reduce the processing time.

10. As per claim 4, Hara discloses a storage unit including a mail address book by which whether or not the reply destination mail address extracted from the mail header of the E-mail received is the address of the mailing list, can be judged [ col 1, lines 10-20 and lines 29-37 ].

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11. As per claim 5, Hara discloses a processing unit which stores [ claim 1, lines 3-4; and col 2, lines 58-59 ], if the mail address extracted from the text of the E-mail received is not registered in the mail address book, a name of this unregistered mail address as a name unknown in the mail address book in a format of corresponding to the mail address [ col 1, lines 35-37; and col 3, lines 56-59 ].

12. As per claim 6, Hara discloses a display unit which displays, when visibly displaying all the extracted mail addresses as the reply destination candidates, the name of the mail address extracted from the text of the received E-mail and unregistered in the mail address book as the name unknown in the format of corresponding to the mail address [ Figure 4 ].

13. As per claims 7, 8, 10-12, they are method claimed of claims 1, 2, 4-6, they are rejected for similar reasons as stated above in claims 1, 2, 4-6.

14. As per claims 13, 14, 16-18, they are program product claimed of claims 1, 2, 4-6, they are rejected for similar reasons as stated above in claims 1, 2, 4-6.

15. Applicant's arguments filed 11/05/2003 have been fully considered but they are not persuasive.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on Monday – Friday (8:00 – 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directly to the receptionist whose telephone number is (703) 305-3900.

Dustin Nguyen



JOHN FOLLANSBEE  
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